

Karrimor International Ltd v Ho Choong Fun t/a Ah Hwa Trading Co

HIGH COURT (SINGAPORE) - ORIGINATING MOTION NO
31 OF 1987
CHUA J
4 AUGUST 1989

Trade Marks - Motion to expunge another's mark - Issue of ownership of mark - Worldwide reputation of applicant - Phonetic similarity between marks - Similarity of appearance between products of applicant and those of respondent - Confusion to trade and public of protection - Trade Marks Act (Cap 332, 1985 Ed), ss 15(1) & 39(1)

Words and Phrases - 'Person aggrieved' - Trade Marks Act (Cap 332, 1985 Ed), s 39(1)

The applicants are a company incorporated in the United Kingdom and are manufacturers and dealers of school bags and knapsacks bearing the name 'Karrimor'. This trade mark had been used since 1958 and the mark had been registered in Great Britain and many foreign countries. The applicants have been distributing and selling such school bags and knapsacks in Singapore through their agents since 1977. The respondent had been distributing and selling similar items with the trade mark 'Karrinor' since 1984. The applicants sought by originating motion to obtain an order that the Register of Trade Marks be rectified by expunging the entry relating to the trade mark 'Karrinor' registered by the respondent and the applicant's trade mark 'Karrimor' be registered under the Act. The respondent claimed that the applicants were not a 'person aggrieved' under s 39(1) of the Trade marks Act.

Held, granting the order:

(1) Within the very large definition in the Act, the applicants were a 'person aggrieved', and the applicants are entitled to make the application.

(2) The applicants have since 1958 acquired a worldwide reputation in their products. The trade and the public exclusively identify 'Karrimor' with the applicants. The phonetic similarity of the applicants' trade mark with that of the respondent's and the similarity in appearance of goods would lead to confusion in the minds of the public.

(3) There was no evidence that the respondent had advertised his products widely. He must have been aware of the applicants' trade mark and he has not explained his choice of trade mark. This indicates that the respondent had copied his trade mark from the applicants. The respondent was not the true proprietor of the mark 'Karrinor'.

(4) The court has a discretion whether to rectify the Register of Trade Marks or not. The demerits of the applicants are irrelevant. The question is not between the applicants on the one hand and the respondent on the other but between the public and the respondent. In view of all the circumstances, the respondent's trade mark should be expunged.

Legislation referred to

Trade Marks Act (Cap 332, 1985 Ed) ss 15(1), 39(1)

Foo Soon Yien (Miss) for the applicants.

B Ganeshamoorthy for the respondent.

Cur Adv Vult

A Chua J: The applicants, who are manufacturers and dealers of school bags and knapsacks bearing the trade mark 'Karrimor', by this originating motion seek an order (i) that the Register of Trade Marks kept under the Trade Marks Act (Cap 332) ('the Act') be rectified by expunging therefrom the entry relating to the trade mark 'Karrinor' Registration No 6176/84 registered in the name of the respondent and (ii) that the applicants' trade mark 'Karrimor' be registered under the Act. At the end of the hearing, I made an order in terms of the motion and ordered the respondent to pay costs. I now give my reasons.

The grounds of the application are that:

C (1) The applicants are persons aggrieved within the meaning of s 39(1) of the Act.
(2) The registration of the trade mark 'Karrinor' by the respondent was and is invalid for the reasons that:

D (a) the respondent is not entitled to claim to be the proprietor of the mark 'Karrinor' for school bags and knapsacks under s 11(1) of the Act as the reputation and goodwill in respect of the business of selling such school bags and knapsacks belong to the applicants;
E (b) it is not lawful to register the trade mark 'Karrinor' as the use of it is likely to deceive or cause confusion by reason of the reputation and goodwill of the applicants.

The respondent submits that the applicants are not persons aggrieved within the meaning of s 39(1) of the Act.

F The arguments of the respondent are these:

(1) To be a 'person aggrieved' the applicants must have used the exact trade mark they wished to have expunged from the Register. The applicants' trade mark is 'Karrimor' whereas the respondent's trade mark is 'Karrinor' with a bull head.
G (2) The applicants have not proved that the trade mark 'Karrimor' has been registered in Great Britain and other foreign countries as claimed by them.
(3) The trade mark 'Karrimor' is not the trade mark of the applicants. They do not have the exclusive use of it.
H (4) The applicants have not proved that they have been distributing and selling their school bags and knapsacks in Singapore since April 1977.

I It appeared to me that the applicants were persons aggrieved within the meaning of the very large definition which had been put upon those words and that the motion was well-founded and that the applicants were entitled to make the application.

The facts are these. The applicants are a company incorporated in the United Kingdom. 'Karrimor' Bags were first manufactured in England by Karrimor Bag Company which became Karrimor Weathertite Products Ltd

in 1948 and Karrimor International Ltd ('the applicants') in 1972. The applicants first carried on business as manufacturers of school bags and knapsacks bearing the trade mark 'Karrimor' in 1958 and they have since then in the course of their business manufactured and sold such school bags and knapsacks and their trade mark 'Karrimor' has been registered in Great Britain and many foreign countries.

The applicants have been distributing and selling such school bags and knapsacks in Singapore, through agents, since 1977 and such goods have been widely advertised in newspapers in Singapore. The sales of such goods in Singapore have been substantial.

The applicants have since 1958 acquired a worldwide reputation in their products. They have acquired a substantial and established reputation and goodwill in the business of 'Karrimor' school bags and knapsacks. The trade and the public exclusively identify 'Karrimor' school bags and knapsacks with the applicants.

The respondent has been distributing and selling school bags and knapsacks with the trade mark 'Karrinor' since only 1984. The school bags and knapsacks which the respondent are selling are very similar in appearance to the products of the applicants. The phonetic similarity of the words 'Karrimor' and 'Karrinor' and the similarity in appearance of the goods would lead to deception or confusion in the minds of the public.

There is no evidence that the respondent had advertised his products widely in newspapers. The respondent must have been well aware of the well-known trade mark of the applicants. He has not explained at all his choice of the trade mark 'Karrinor' which is very similar to 'Karrimor'. The name of the applicants contains the trade mark 'Karrimor'. This fact clearly indicates that the respondent did not independently devise his trade mark but in fact copied it from the applicants' trade mark. The respondent in truth is not the true proprietor of the mark 'Karrinor'. There is no doubt that the respondent is trying to obtain the benefit of the worldwide reputation of the applicants.

Section 15(1) of the Act provides:

It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.

The court always has a discretion under s 39 whether to rectify the Register or not in the light of all the circumstances of the case. The demerits of the applicants are irrelevant to the question whether rectification should be ordered, or not, at least where a likelihood of confusion is established. The question is not between the applicants on the one hand and the respondent on the other, but be-

tween the public and the respondent (see *Kerley's Law of Trade Marks & Trade Names* (11th Ed) p 175 para 11-29).

I was of the view that, in all the circumstances of the case, the court should exercise its discretion to expunge the respondent's registered trade mark from the Register. For these reasons I granted the application of the applicants.

Application granted.

Solicitors: *Bernard Rada & Lee; Lim Ganesh & Liu.*

Reported by *Terence Tan Bian Chye*

Che Som bte Yip & Ors v Maha Pte Ltd & Ors (Maha Pte Ltd & Anor, Third Parties)

HIGH COURT (SINGAPORE) - SUIT NO 2788 OF 1978
CHAO HICK TIN JC
30 JUNE 1989

Contract - Undue influence - Capacity - Requirements for setting aside contract where one party of unsound mind - Whether one party knew of other party's unsound mind - Constructive knowledge - Whether borrower was agent of lender in procuring security from surety

Land Law - Mortgage - Mortgage deed executed by person of unsound mind - Whether binding

Evidence - Expert evidence - Conflict between psychiatrists as to unsoundness of mind of party

Agency - Creation of - Lender asking borrower to procure security from surety - Imputation of knowledge of agent to principal

The first and second plaintiffs are the committee of the estate of the third plaintiff, having been appointed by orders of court under the Mental Disorders and Treatment Act (Cap 178, 1985 Ed). The present action was taken by the first and second plaintiffs for and on behalf of the third plaintiff for a declaration that a deed of mortgage ('the deed') of a certain property ('the property'), allegedly executed by the third plaintiff in favour of the third defendant, be declared null and void and of no legal effect. It was alleged that the third plaintiff was, at the time of the execution of the mortgage deed, of unsound mind and incapable of managing himself and his affairs. They also sought a declaration that all consequential entries made at the Registry of Titles and Deeds be declared null and void. The deed was executed between the first defendant of the first part, the second defendant and the third plaintiff of the second part and the third defendant of the third part. The third defendant is a foreign bank carrying on business in Singapore. The mortgage was executed as part security for banking facilities granted by the third defendant to the first defendant. The second defendant and the third plaintiff are the tenants in common in equal shares of the property.

A consultant psychiatrist appeared as witness for the plaintiffs and testified that anyone having a conversation with the third plaintiff for five to ten minutes would have great doubts